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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/413,110 10/06/99 UNGER

E UNGR-1580

EXAMINER

HM12/0411

DAVID A CHERRY ESQ
WOODCOCK WASHBURN KURTZ
MACKIEWICZ & NORRIS LLP
ONE LIBERTY PLACE 46TH FLOOR
PHILADELPHIA PA 19103

SHARAREH S

ART UNIT

PAPER NUMBER

1616
DATE MAILED:

04/11/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/413,110

Applicant(s)

Evan Unger

Examiner

Shahnam Sharar h

Group Art Unit

1616

☒ Responsive to communication(s) filed on Oct 6, 1999

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 1 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

☒ Claim(s) 1-74 is/are pending in the applicat

Of the above, claim(s) _____ is/are withdrawn from consideration

☐ Claim(s) _____ is/are allowed.

☐ Claim(s) _____ is/are rejected.

☐ Claim(s) _____ is/are objected to.

☒ Claims 1-74 are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☒ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

Art Unit: 1616

DETAILED ACTION

Election/Restriction

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-62, 68-74 drawn to methods of enhancing bioavailability of a bioactive agent, classified in class 424, subclass 450 or 489.
 - II. Claims 63-71, drawn to methods of treating a thrombus, classified in class 600, subclass 3.

2. The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the invention I

methods are also utilized to enhance therapeutic delivery of chemotherapeutic agents for treatment of cancer without the administering a thrombolytic agent. The subcombination has separate utility such as treatment of pulmonary embolism.

3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper. Furthermore, the search required for Group I is not required for Group II, therefore, restriction for examination purposes as indicated is proper.

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4. Claims 1-74 are generic to a plurality of methods utilizing structurally and patentably distinct species comprising (1) various fluorinated gaseous or gaseous precursor compounds (2) various bioactive agents (3) various phospholipids, proteins or polymers (3) various target tissues (4) and various flushing rates. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species, even though this requirement is traversed. Currently, claims 1, 49, 63 are generic.

Applicant is advised that a reply to this requirement must include both: (1) an identification of the ultimate species that is elected consonant with this requirement, and (2) a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

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5. A telephone call was made to Mr. David Cherry on 3/29/2000 to request an oral election to the above restriction requirement, but did not result in an election being made.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shahn timer Sharareh, PharmD whose telephone number is (703) 306-5400.

sjs 3/29/2000



S. MARK CLARDY
PATENT EXAMINER
GROUP 1200-1616

Att. SPE